

REMARKS

This paper is responsive to the Final Office Action ("Office Action") dated August 9, 2011, in which the Office rejects claims 10-14 and 17-34. Claims 1-9, 15-16, and 35-40 have been withdrawn. Thus, upon entry of this paper, claims 10-14 and 17-34 will remain pending in the Application, with claim 10 written in independent form. Applicants believe these Remarks are fully responsive to the rejections and/or objections in the Office Action.

Rejection under 35 U.S.C. § 103

Independent claim 10 and dependent claims 12-14, 17, 19-21, 23-26, 28-30, 33, and 34 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Salvati (U.S. Patent No. 5,373,317) in view of Hill (U.S. Patent No. 6,929,600) and Murata (U.S. Published Application No. 2001/0051762), and in further view of Chikama (U.S. Patent No. 5,002,041). Dependent claim 11 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Salvati in view of Hill and Murata and Chikama and in further view of Pearlman (U.S. Patent No. 5,347,992). Dependent claims 18, 22, 21-32 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Salvati in view of Hill and Murata and Chikama and in further view of Saito (U.S. Patent No. 6,184,922). Accordingly, all of the obviousness rejections rely upon the combination of four prior art references – Salvati, Hill, Murata, and Chikama – which is used to reject independent claim 1. As will be explained, since these references, either alone or in combination, fail to disclose or teach at least one of the claim elements required by independent claim 10 (and therefore all dependent claims), Applicants respectfully request reconsideration and withdrawal of the rejections.

The Office bears the initial burden to support any *prima facie* conclusion of obviousness (MPEP §2142). Under §103, the scope and content of the prior art are to be determined, differences between the prior art and the claims at issue are to be ascertained, and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented (*KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1733 (2007) (quoting *In re Graham v. John Deere Co. of Kansas City*, 86 S. Ct. 684 (1966))).

An essential step in determining whether an invention is obvious is consideration of the elements being claimed (MPEP §2143.03). But rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support a legal conclusion of obviousness (*In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007))).

In the instant case, the Office must do more than merely “consider” each and every feature the claims recite. Rather the Office must illustrate that the combination of prior art references teaches or suggests each and every claim feature (See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art)). Applicants respectfully submit none of the cited references, alone or in combination, disclose several elements of the rejected claims and therefore request the obviousness rejections be withdrawn and the claims allowed.

As described in Applicants’ specification and figures, all of the pending claims require a “a unitary control and display handset element [550] comprising a screen element for viewing the interior of the structure and an articulation control element.” In addition, claim 10 requires “a **plurality of insertion elements** [560] for imaging the interior of the structure, each of said plurality of said insertion elements comprising an imaging sensor and an elongated braided portion, wherein said plurality of insertion elements include at least two insertion elements have different physical or optical characteristics,” “wherein each one of said plurality of insertion elements can be directly connected to said unitary

control and display handset element,” and “wherein each one of said plurality of insertion elements can be used without modification of said unitary control and display handset element.”

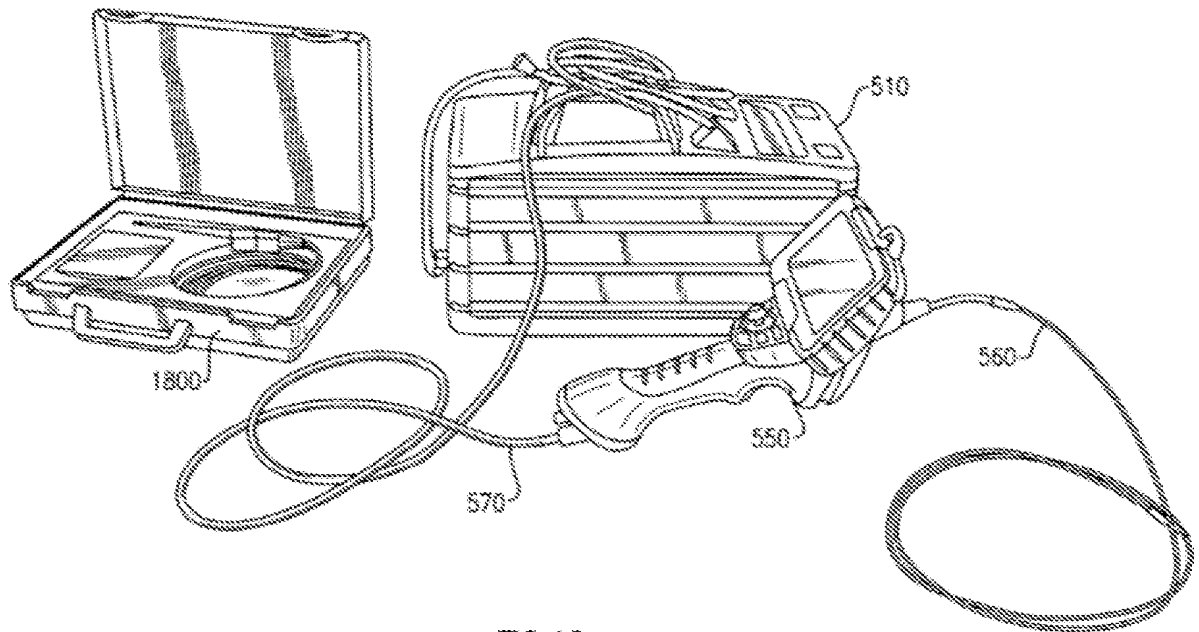


FIG. 18

Applicants’ claims are distinguishable from the cited prior art in that they are directed to a modular visual inspection system having a **plurality of insertion elements comprising an imaging sensor** directly connected to the unitary control and display handset element, which provides the user with greater flexibility in customizing the system and selecting an appropriate insertion element when conducting an inspection. (e.g., Specification at [0078]).

Attempting to find these claim elements in the cited prior art references, the Examiner alleges that “Hill discloses a plurality of insertion elements . . . wherein said plurality of insertion elements include at least two insertion elements having different

physical or optical characteristics," relying upon the disclosure in Hill of a "variety of endotracheal tubes having various lengths." (Hill at 10:19) As is clearly shown in each of the embodiments disclosed in Hill while there is disclosure of a "variety of endotracheal tubes having various lengths," the tubes are hollow "flexible, plastic" tubes inserted "into the patient's trachea to ventilate his/her lungs" (Hill at 1:15-17), not insertion elements for imaging as required by the pending claims. In fact, the particular section of Hill cited by the Examiner explains how a single insertion element for imaging can be used for a variety of different endotracheal tubes having various lengths by using "a connector 136 (see FIG. 5c) which is slidably mounted on the stylet 104" such that "the connector 136 can be slid up and down the stylet 104 to provide connection to the universal adaptor 140 for a variety of endotracheal tubes having various lengths."

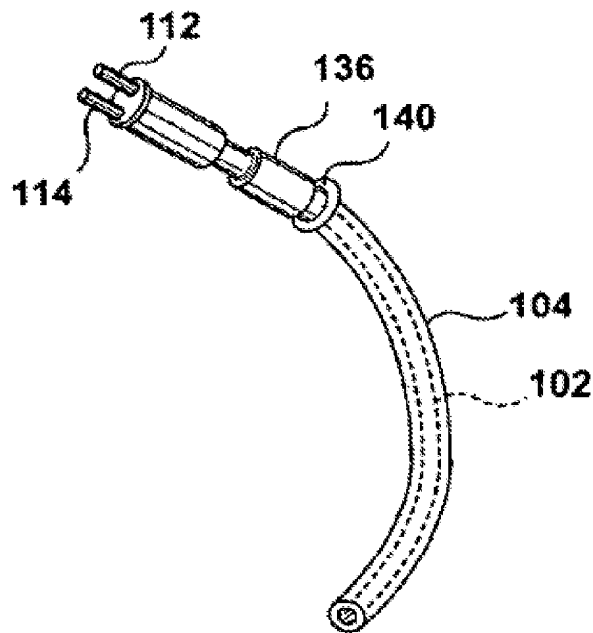


FIG. 5c

This disclosure in Hill confirms that additional hardware is required to accommodate the use of a single video insertion element and actually teaches away from using a plurality of video insertion elements as Applicants claim. Accordingly, Hill is no different than the other prior art references, including the primary Salvati reference where a single insertion element for imaging is connected to the handset. Applicants therefore respectfully disagree that Hill discloses or teaches the presently claimed plurality of insertion elements for imaging the interior of the structure, each of said plurality of said insertion elements comprising an imaging sensor and an elongated braided portion, wherein said plurality of insertion elements include at least two insertion elements have different physical or optical characteristics. Obviously then, Hill and any of the other cited prior art references also fail to disclose the connection of a plurality of insertion elements to the unitary control and display handset element, without modification of the handset. In light of this missing element, Applicants respectfully request reconsideration and withdrawal of the rejections of the pending claims.

CONCLUSION

While Applicants herein may have highlighted a particular claim element of a claim for purposes of demonstrating an insufficiency of an examination on the part of an Examiner, Applicants' highlighting of a particular claim element for such limited purpose should not be taken to indicate that Applicants have asserted the argument of patentability that a particular claim element constitutes the sole basis for patentability out of the context of additional combinations of elements of the claim or claims in which it is present.

Regarding the claims discussed herein, Applicants' selective treatment and emphasis of independent claims of the application should not be taken as an indication that Applicants believe that the Examiner's dependent claim rejections are otherwise sufficient. Applicants expressly reserve the right to present arguments traversing the propriety of the dependent claim rejections later in the prosecution of this or another application.

It is believed that all of the pending claims have been addressed. However, failure to address a specific rejection, issue, or comment in the present file history does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made in the present file history are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in the present file history should be construed as an intent to concede any issue with regard to any claim, except as specifically stated, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Accordingly, in view of the above amendments and remarks, Applicants believe all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-3010, under Order No. 216754; 3052622US01 from which the undersigned is authorized to draw.

Dated: October 11, 2011

Respectfully submitted,

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